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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/553,955   | 08/10/2006  | Xavier Barrilalonso  | 010180.00041        | 1004             |
| 22907 7590 02/29/2008<br>BANNER & WITCOFF, LTD.<br>1100 13th STREET, N.W.<br>SUITE 1200<br>WASHINGTON, DC 20005-4051 |             |                      |                     |                  |
| EXAMINER   |             |                      |                     |                  |
| COPPINS, JANET L   |             |                      |                     |                  |
| ART UNIT   |             | PAPER NUMBER         |                     |                  |
| 1626   |             |                      |                     |                  |
| MAIL DATE  |             | DELIVERY MODE        |                     |                  |
| 02/29/2008   |             | PAPER                |                     |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/553,955

**Applicant(s)**

BARRILALONSO ET AL.

**Examiner**

JANET L. COPPINS

**Art Unit**

1626

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20, 23 and 24 is/are pending in the application.
- 4a) Of the above claim(s) 4-8, 12-15 and 18-20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 9-11, 16, 17, 23 and 24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date 10/19/05.
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

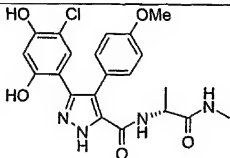
1. Claims 1-20, 23 and 24 are pending in the instant application.

#### *Information Disclosure Statement*

2. Applicants' Information Disclosure Statement (IDS), submitted October 19, 2005, has been considered by the Examiner. Please refer to the signed copy of Applicants' PTO-1449 form, attached herewith.

#### *Lack of Unity*

3. Examiner Lambkin required an election of species in the finding of Lack of Unity of September 19, 2007. The Examiner notes with appreciation Applicants' election of the compound of Example 13:



in the response filed January 11, 2008. The compound is readable on claims 1, 2, 3, 9, 10, 11, 16, 17, 19, 20, 23 and 24.

4. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the

currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### *Status of the Claims*

6. Claims 1-20, 23 and 24 are pending in the instant application. Applicants have elected the species of Example 13, as discussed above. In view of a fair interpretation of the claims, the scope of the invention of the elected subject matter is as follows:

Compounds and compositions of Formula (I), depicted in claim 1, wherein: **R<sub>1</sub>** and **R<sub>2</sub>** each contain aryl radicals, and the remaining variables are as defined in the claims.

As a result of the election and the corresponding scope of the invention identified above, the remaining subject matter of claims 1-20, 23 and 24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b). Accordingly claims 4-8, 12-15 and 18 are **withdrawn** in full, as well as method of use claims 19 and 20. The non-elected subject matter of pending claims 1-3, 9-11, 16, 17, 23 and 24 is also withdrawn. The withdrawn compounds contain varying functional groups which are chemically recognized to differ in structure and function.

The Examiner refers to PCT Rule 13.1:

The international application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept.

Applicants' instant claims do not relate to a single invention, the application is drawn to multiple product inventions. The multiple inventions are not so linked as to form a single general inventive concept because according to PCT Rule 13.2:

Where a group of inventions is claimed in one and the same international application, the requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features.

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The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

Applicants' instant claims do not contain a special technical feature that defines a contribution over the prior art. Attached to the instant office action is a copy of a reference that provides that the technical feature, which can be taken as a whole amongst all the alternatives, as depicted above, is not a 'special technical feature' as defined in PCT Rule 13.2, by failing to define a contribution over the prior art, as it was known in the art prior to the filing of the instant application. Please refer to the WO document, which discloses the same "special technical feature," and supports the Examiner's position that Applicants' compounds fail to define a contribution over the prior art. Therefore, since the substituents on the technical feature vary extensively and when taken as a whole result in vastly different compounds, and unity of inventions is considered to be lacking and restriction of the invention in accordance with the rules of unity of invention is considered to be proper and according to PCT Rule 3.3:

The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

Therefore, since the claims do not contain a special technical feature, which defines a contribution over the prior art, the Examiner may determine within a single claim that the inventions are not so linked as to form a single general inventive concept.

Therefore, the finding of Lack of Unity is still deemed proper.

#### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

8. Claims 1- 3, 9-11, 16, 17, 23 and 24 rejected in part under 35 U.S.C. 102(e) as being anticipated by WO 03/055860 A1 to Drysdale et al. The WO document designates the U.S. and was filed as well as published in English, with a filing date of December 19, 2002. Please refer to MPEP 2136[R-3],

"The prior art date of a reference under 35 U.S.C. 102(e) may be the **international filing date** if the international filing date was on or after November 29, 2000, the international application designated the United States, and the international application was published by the World Intellectual Property Organization (WIPO) under the Patent Cooperation Treaty (PCT) Article 21(2) in the English language."

The instant application was filed August 10, 2006, claims benefit of foreign priority to a UK patent application that was filed April 28, 2003.

The WO document teaches 3,4-diarylpyrazoles that read on compounds of the instant invention, please refer to compounds of formula (1) wherein "Ar<sup>3</sup> and Ar<sup>4</sup>" are both optionally substituted aryl, and "R<sup>5</sup>" is -C(=O)R<sup>1</sup>R<sup>2</sup> wherein one of R<sup>1</sup> and R<sup>2</sup> is carboxamide (please see page 36, lines 8-16). Please refer for example, specifically to the compound on page 232, lines 12-23, as well as compounds on pages 233.

***Conclusion***

9. In conclusion, claims 1-20, 23 and 24 are pending in the application, claims 4-8, 12-15 and 18 are currently withdrawn, and claims 1- 3, 9-11, 16, 17, 23 and 24 are rejected.

***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JANET L. COPPINS whose telephone number is (571)272-0680. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571.272.0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Janet L. Coppins  
February 18, 2008

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/Kamal A. Saced/  
Primary Examiner, Art Unit 1626